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17818

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/533,904 03/21/00 KETTUNEN

A 10-1304

EXAMINER

IM52/0808

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Arlington VA 22201-4714

NGUYEN, T

ART UNIT

PAPER NUMBER

1731

/2

DATE MAILED:

08/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/533,904

Applicant(s)

KETTUNEN

Examiner

Dean T. Nguyen

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 6/28/01 and 7/13/01.

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-21 and 47-53 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☒ Claim(s) 1-21 is/are allowed.

6) ☒ Claim(s) 47-53 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☒ Other: statement under 37 CFR 3.73(b)

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DETAILED ACTION

Original Patent

1. The original patent grant U.S. Patent No. 5,779,856 has been received.

Statement Under 37 CFR 3.73(b)

2. This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest in order to support the consent to a reissue application required by 37 CFR 1.172(a). The assignee's ownership interest is established by:

(a) filing in the reissue application evidence of a chain of title from the original owner to the assignee, or

(b) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. See MPEP § 1410.01.

An appropriate paper satisfying the requirements of 37 CFR 3.73 must be submitted in reply to this Office action. See attached sheet.

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Claim Rejections Based Upon Recapture

3. Claims 47-53 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

In application 08/736,112, which matured into U.S. Patent 5,779,856, applicant amended claim 16 to include the limitation in step (e) that the spent second (2nd) cooking liquor possessed an effective alkali concentration of greater than about "20 g/l".

Similarly, claim 16 was also amended to recite the limitation that during at least the last fifteen minutes of step (e), the effective alkali concentration is between "20-40 g/l, so as to produce chemical pulp having enhanced intrinsic fiber strength compared to if the effective alkali concentration was below 15 g/l during the last fifteen minutes of step (e)".

Both of these amendments to claim 16 were made to overcome the rejections involving US Patent 5,522,958 to Li. See the amendment of November 12, 1997, page 10, first and second paragraphs. Newly added claim 47, however, does not include these limitations which applicant presented in application 08/736,112 to overcome the prior art of record.

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Thus, applicant is attempting to recapture subject matter which was surrendered in application 08/736,112.

Claim Rejections - 35 USC § 112

4. Claims 47-53 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 47 calls for "a 2nd effective alkali (EA) concentration being between about 15 g/l and about 60 g/l greater than the 1st EA concentration" which is not supported in the specification because col. 4, lines 8-10 (see also argument on amendment filed 6/28/01, page 2, 2nd paragraph), shows that the final or 2nd EA concentration is at most 60 g/l while the 1st EA concentration is greater than 10 g/l as shown on col. 3, lines 1-3 (see also remarks on page 2 of 6/28/01 amendment). Therefore, the upper limit for the difference between 1st EA concentration to 2nd EA concentration can be no more than $60 - 10 = 50$ g/l.

Claim Rejections - 35 USC § 251

5. Claims 47-53 are also rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows: claim 47 calls for "a 2nd effective alkali (EA) concentration being between about 15 g/l and about 60 g/l greater than the 1st EA

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concentration” which is not supported in the specification because col. 4, lines 8-10 (see also argument on amendment filed 6/28/01, page 2, 2nd paragraph), shows that the final or 2nd EA concentration is at most 60 g/l while the 1st EA concentration is greater than 10 g/l as shown on col. 3, lines 1-3 (see also remarks on page 2 of 6/28/01 amendment). Therefore, the upper limit for the difference between 1st EA concentration to 2nd EA concentration can be no more than $60-10 = 50$ g/l.

Response to Arguments

6. Applicant's arguments with respect to the 35 U.S.C. 112, first paragraph, of claims 22-46 filed 6/28/01 are persuasive and the rejections have been withdrawn. However, they are moot in view of the new ground(s) of rejection.

The Final rejection of 3/7/01 has been withdrawn due to new rejections above.


7. When filing a FAX in Group 1300, please indicate in the Header (upper right) “Official” for papers that are to be entered into the file, and “Unofficial” for Draft Documents and other Communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dean T. Nguyen whose telephone no. is (703) 308-2053. The examiner can normally be reached on Monday-Friday @ 7:00-4:00 PM (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stan Silverman, can be reached on (703) 308-3837. The fax phone number for this group is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose tel. No. is (703) 308-0651.

dtm
August 7, 2001


DEAN T. NGUYEN
PRIMARY EXAMINER

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

STATEMENT UNDER 37 CFR 3.73(b)

Applicant/Patent Owner: _____

Application No./Patent No.: _____ Filed/Issue Date: _____

Entitled: _____

_____, a _____,
(Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

1. ☐ the assignee of the entire right, title, and interest; or
2. ☐ an assignee of less than the entire right, title and interest.
The extent (by, percentage) of its ownership interest is _____ %

in the patent application/patent identified above by virtue of either:

- A. ☐ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

OR

- B. ☐ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as shown below:

1. From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

2. From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

3. From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

- ☐ Copies of assignments or other documents in the chain of title are attached.
[NOTE: A separate copy (i.e., the original assignment document or a true copy of the original document) must be submitted to Assignment Division in accordance with 37 CFR Part 3, if the assignment is to be recorded in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

Date_____
Typed or printed name_____
Signature_____
Title